Paper No. 33

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte ARTHUR A. BRANSTROM, DONATA R. SIZEMORE, and JERALD C. SADOFF

Appeal No. 2001-1881
Application No. 08/711,961

ON BRIEF

Before WINTERS, ADAMS, and GREEN, Administrative Patent Judges.

GREEN, Administrative Patent Judge.

REQUEST FOR REHEARING

On December 22, 2003, this panel issued a decision on appeal in which we summarily affirmed the obviousness-type double patenting. In that decision, we noted:

> Even though we now have new claims 56, 57, 59-62 and 64-65 before us, appellants do not dispute that the new claims are subject to the obviousness-type double patenting rejection affirmed in the May Decision on Appeal. Appellants' only remarks were that they would file a Terminal Disclaimer, which has not been filed at this time. See Paper No. 29. Under these facts, we summarily affirm the obviousness-type double patenting rejection as to newly entered claims 56, 57, 59-62 and 64-65.

Decision on Appeal mailed December 22, 2003, page 2.

In the Request for Reconsideration, Appellants request reconsideration of the above decision on the grounds that a terminal disclaimer was filed in the application on October 17, 2003. Appellants have also attached a copy of the Terminal Disclaimer to the Request for Reconsideration. The function of the Board in the ex parte context, however, is to review rejections. The Board does not perform examining functions in the first instance, and a terminal disclaimer must be proffered to the relevant Technology Center and the examiner, rather than to the Board. See MPEP § 1490.

Moreover, an obviousness-type double patenting rejection of claim 45-55 was before us in the Decision on Appeal mailed May 30, 2003, and as appellants had not argued the merits of the rejection, and as a terminal disclaimer had not been filed, that rejection was also affirmed. The Request for Reconsideration does not provide an explanation as to why the terminal disclaimer filed October 17, 2003, after our first decision on appeal, was timely filed.[1] Accordingly, appellants request for rehearing is denied.

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[1] See In re Deters, 515 F.2d 1152, 1157, 185 USPQ 644, 48 (CCPA 1975) ("Since no terminal disclaimer was timely filed, we sustain . . . [the obviousness-type double patenting] rejection."); Cf. In re Jursich, 410 F.2d 803, 807, 161 USPQ 675 (CCPA 1969), footnotes and citations omitted, ("The record shows that appellants' assignee filed a terminal disclaimer in the Patent Office after the board decision which the board refused to consider because it was not timely presented or considered by the examiner. Appellants assign error in that action by the board, arguing that the terminal disclaimer 'eliminated the double patenting issue in the present case.' However accurate that statement may be, we cannot consider the disclaimer here. . . .").

CONCLUSION

For the reasons set forth above, Appellant's Request for Rehearing is denied.

REQUEST FOR REHEARING-DENIED

Sherman D. Winters)
Administrative Patent Judge)
)
)
Donald E. Adams) BOARD OF PATENT
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